

**REMARKS**

In the Office Action dated October 24, 2005, claims 1-14 were presented for examination. Claims 6-8 were rejected under 35 U.S.C. §101. Claims 1-14 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1, 6, and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by *Smith*, U.S. Patent No. 5,832,068. Claims 1, 5, 6, 9, and 13 were rejected under 35 U.S.C. §102(a) as being anticipated by *Applicant's Admitted Prior Art (AAPA)*. Claims 2-4, 7, 8, 10-12, and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* in view of *Applicant's Admitted Prior Art (AAPA)*.

The following remarks are provided in support of the pending claims and responsive to the Office Action of October 24, 2005 for the pending application.

**I. Rejection of Claims 6-8 under 35 U.S.C. §101**

In the Office Action dated October 24, 2005, the Examiner assigned to the application rejected claims 6-8 under 35 U.S.C. §101, as being directed to non-statutory subject matter. The Examiner alleges that the independent claim is not tangibly embodied. Applicant has amended claim 6 to further delineate the data structure, the medium in which the data structure resides, and the instructions for processing data with respect to the data structure and the medium. The amendment more specifically defines Applicant's invention with respect to a tangible item and not merely an abstract idea. Accordingly, Applicant respectfully requests that the Examiner remove the rejection of claims 6-8 under 35 U.S.C. §101.

**II. Rejection of Claims 1-14 under 35 U.S.C. §112, second paragraph**

In the Office Action dated October 24, 2005, the Examiner assigned to the application

rejected claims 1-14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, with respect to claim 1, the Examiner has noted items on lines 7-9 are indefinite with respect to the identification of a duplicate data item. Applicant has amended this portion of claim 1 to specifically claim the identification process as based upon a comparison of status identifiers from at least two of the input streams. The Examiner has further alleged indefiniteness with respect to lines 7 and 8 of claim 1 with respect to whether the first and second input streams are used or created. Applicant has amended claim 1 to clarify that data items are from two or more input streams are being compared, and based upon the comparison, a data item from one of the input streams is placed into a single output stream. The amendment clarifies that the input streams are provided and the output stream is created through the placement process. Finally, with respect to the Examiner's issue with the input streams being an odd number greater than one, Applicant has not amended claim 1. Applicant clearly states in the preamble of claim 1, that there are two or more input streams. At any one time, status identifiers are being compared from two input streams. Switching input streams can be from stream one, to stream two, to stream three, etc. The fact that the preamble specifically states two or more input streams together with the broad language of comprising in the preamble provides support for the fact that there may be two or more input streams. Based on the above and Applicant's amendments to claim 1, Applicant respectfully requests that the Examiner remove the rejection of claim 1 and its dependent claims under 35 U.S.C. §112, second paragraph.

With respect to claim 6, Applicant has amended the language of the claim to clarify the term "merging". Furthermore, Applicant has amended the language of the claim to clarify the element of the duplicate identifier, how an item is identified as being a duplicate, and how such a duplicate data item is resolved with respect to the output stream and with respect to switching among input streams. Based on Applicant's amendments to claim 6, Applicant respectfully requests that the Examiner remove the rejection of claim 6 and its dependent claims under 35 U.S.C. §112, second paragraph.

### III. Rejection of claims 1 and 9 under 35 U.S.C. §102(b)

In the Office Action dated October 24, 2005, the Examiner assigned to the application rejected claims 1, 6, and 9 under 35 U.S.C. §102(b) as being anticipated by *Smith*.

The remarks pertaining to *Smith* provided in the response to the prior Office Actions are hereby incorporated by reference.

As noted in the Response to the Second Office Action, *Smith* has a record index and compares a received record with records stored in the index. In response to the received record being a duplicate of a record already present in the index, the duplicate record is placed in a secondary list known as an exclusion list. As noted in Col. 8, lines 50-52 of *Smith*, in response to a duplicate item "the retrieved record is discarded and not processed." Furthermore, as shown in both Figs. 3 and 4 of *Smith*, the process continues receiving records from an external source and comparing each received record with the records already present in the index. Accordingly, *Smith* teaches a process for comparing received data records with a data record index and placing non-duplicate received records into the index. The data record index of *Smith* is static in that all received data records are compared to the index. The external source, which provides data to be compared and placed in the index, is the only element that may change. However, the index and the received data records of *Smith* are never switched. Whereas, it is the comparable elements in Applicant's invention that are switched.

Applicant's invention functions on a different principal than that taught in *Smith*. As in *Smith*, Applicant compares data based on identifiers associated with the data and places the data into a single output stream. The index of *Smith* appears to be comparable to the output stream of Applicant as both of these items are the compilation of non-duplicate records. However, the similarities between *Smith* and Applicant are seen in response to receipt and comparison of a duplicate record. *Smith* discards the duplicate record and continues to receive records for comparison to the same index, *i.e.* input stream. Applicant does not discard the duplicate record. Rather, Applicant places the duplicate record in the output stream, which is the compilation of

the index of *Smith*, and Applicant changes the input streams as a basis for comparison in response to receipt of a duplicate record. As noted in the amended claim language, Applicant switches to the input stream that produced the duplicate record as the basis to receive the next record from one of the other input streams. Applicant's invention differs from *Smith* in the manner in which the output stream is built, *i.e.* the index of *Smith*, together with the switching of input streams. It is clear that *Smith* does not teach all of the elements as presented in Applicant's amended claims 1, 6, and 9. Accordingly, Applicant respectfully requests that the Examiner remove the rejection of claims 1, 6, and 9, as amended.

#### **IV. Rejection of claims 1, 5, 6, 9, and 13 under 35 U.S.C. §102(a)**

In the Office Action dated October 24, 2005, the Examiner assigned to the application rejected claims 1, 5, 6, 9, and 13 under 35 U.S.C. §102(a) as being anticipated by Applicant's Admitted Prior Art (*AAPA*). As noted in the Response to the Second Office Action, the *AAPA* relates to merging two or more input data streams into a single sorted output stream. Pages 1 and 2 of Applicant's specification discuss the *AAPA*. As noted on these pages of the specification, the *AAPA* addresses forming a single output stream from multiple input streams. The *AAPA* also notes that there is only one known prior art solution for addressing duplicate data items discovered during the formation of the single output stream and that this solution only functions efficiently when "the number of input streams is an even power of 2". See page 2, last paragraph, through page 3, lines 1-5. Applicant has amended the independent claims to more specifically define Applicant's invention and how it functions when there are an odd number of input streams, *i.e.* an odd number of three or greater. The *AAPA* fails to illustrate an equitable solution for managing input streams containing duplicate data items in the manner claimed by Applicant when there is an odd number of three or more input streams. Accordingly, Applicant respectfully requests that the Examiner remove the rejection of claims 1, 5, 6, 9, and 13.

#### **IV. Rejection of claims 2-4, 7, 8, 10-12, and 14 under 35 U.S.C. §103(a)**

In the Office Action dated October 24, 2005, the Examiner assigned to the application

rejected claims 2-4, 7, 8, 10-12, and 14 under 35 U.S.C. §103(a) as being unpatentable over *Smith*, U.S. Patent No. 5,832,068, in view of *Applicant's Admitted Prior Art (AAPA)*.

The comments pertaining to *AAPA* and *Smith* in the Response to the prior Office Actions, and above are hereby incorporated by reference.

There is no teaching in *AAPA* for an indicator to be an integer corresponding to one of four values. At most, *AAPA* teaches only three of the four values, and an algorithm responsive to the three identified values. As noted by the Examiner in Section III, "0 is equal or duplicate". See Second Office Action, page 4. The *Smith* patent teaches identifying duplicate records. See Fig. 3. However, whether considered individually or combined, the *AAPA* and *Smith* patent do not teach the four integer options as claimed by Applicant. "To establish a prima facie case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *AAPA* does not teach the four integer options as claimed by Applicant. In fact, at most *AAPA* may only be interpreted to include three of the four integer options. Similarly, *Smith* teaches the duplicate integer option, but does not teach the four options claimed by Applicant.

In order to apply *AAPA* to Applicant's pending application, the *AAPA* must be modified and reconfigured to support the four integer options of Applicant. However, utilizing Applicant's four integer options goes against the teachings of *AAPA*. "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990)). *AAPA* does not teach or suggest the four integer options as claimed by Applicant. To read *AAPA* as providing or supporting all four of these integer options would require a modification to the invention of *AAPA* not envisioned or required. Similarly, to read *Smith* as providing the fourth option not taught in the *AAPA* would

require a modification to the invention of *Smith* not envisioned or required. *Smith* does not teach the fourth integer missing from *AAPA*. *Smith* teaches identifying duplicate records. As noted by the Examiner, the duplicate integer is taught in the *AAPA*, it is the *AAPA*'s response to the duplicate integer that differs from Applicant. The only suggestion for each of the four integer options is derived from Applicant's invention. Absent Applicant's invention, there is no suggestion or motivation within *AAPA* or *Smith* for such modifications. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet this is the very process that the Examiner has attempted to undertake.

Even if as a general matter it would be trivial to combine the teachings of *AAPA* with the teachings of *Smith*, it would not necessarily be obvious to combine them in view of one another. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. See MPEP §2143. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." MPEP §2143, (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Here *AAPA* teaches the use of three options. However, as noted by the Examiner, *AAPA* fails to teach or suggest the use of four options. While *Smith* teaches identification of duplicate records, duplicate is one of the four integers identified in the *AAPA* - it is not the missing option, there is no suggestion of employing a four integer option. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination." MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). The only suggestion for the combination of elements that form Applicant's invention is found in Applicant's invention. Accordingly, the Applicant respectfully submits that claims 2-4, 7, 8, 10-12, and 14 would not have been obvious for the above outlined reasons and allowance of these claims is respectfully requested.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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